



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 8

**O'KEEFE EGAN & PETERMAN LLP
BUILDING C, SUITE 200
1101 CAPITAL OF TEXAS HIGHWAY SOUTH
AUSTIN, TX 78746**

COPY MAILED

SEP 15 2003

OFFICE OF PETITIONS

In re Application of :
Scott C. Johnson et al :
Application No. 09/879,810 :
Filed: June 12, 2001 :
Attorney Docket No. SURG:147 :

: DECISION ON PETITIONS
: UNDER 37 CFR 1.181; 37
: CFR 1.183 AND 37 CFR
: 1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

The petition under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.183 is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

BACKGROUND

The above-identified application was filed on June 12, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 3, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B)(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B)(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

- (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
- (ii) **An applicant may rescind a request made under clause (i) at any time.**
- (iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall

notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. **A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned**, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).¹

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed “in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application.” See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45837 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

¹ Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 3, 2002, 77 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 3, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 3, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

- (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
- (4) When an application is abandoned by operation of 35 U.S.C.

122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.

(5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 3, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the international application.

In view of the above, this application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

- (1) the reply, which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Telephone inquiries regarding this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy